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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/798,786

Filing Date: March 10, 2004

Appellant(s): VAN TASSEL ET AL.

Boston Scientific Corporation
For Appellant

A statement identifying by name the real party in interest is contained in the brief.

This is in response to the appeal brief filed 10/29/2008 appealing from the Office action mailed 5/29/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Laufer et al. 6,488,673

Trauner et al. 5,913,884

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 61, 62, 64-66 and 68 are rejected under 35 U.S.C. 102(e) as being anticipated by Laufer et al. (6,488,673). Laufer et al. disclose a method of applying light energy to the inner wall of a vessel via a light delivery catheter without occluding fluid flow (Figure 37 and 38 and the light having a UV wavelength of 240-350 nm) after applying a photo-activatable agent (a psoralen agent injected intravenously) to the vessel and which is necessarily taken up by the wall and the adventitial area of the vessel (as disclosed by the applicant's specification) and see col. 9, lines 44-52, col. 11, lines 8-38, col. 16, lines 30-53, col. 26, line 38-col. 27, line 27 and col. 27, line 67-col. 29, line 11).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 63, 69-71and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laufer et al. in view of Trauner et al. (5,913,884).

Laufer et al. fail to disclose local administration of the photo-activatable agent, However, Trauner et al. disclose that local and systemic administration are both effective or equivalent with a waiting period required when the administration is systemic (col. 7, lines 14-32).

As to claims 69-71 and 73, Laufer et al. fail to disclose irradiating the target region externally using an external light source. However, Trauner et al. disclose the light can be delivered via optical fibers internally or can be provided extracorporeally by transillumination (col. 7, lines 44-60). Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the method of Laufer et al. as taught by Trauner et al., to provide the irradiation externally since this is an alternative equivalent means of applying the light energy to activate the photo-activatable agent.

Allowable Subject Matter

Claim 67 is allowed.

(10) Response to Argument

The applicant has argued that the examiner's rejection based on inherency has not included a basis in fact and/or technical reasoning to reasonably support that applying light energy to the inner wall necessarily results in the light being taken up by the adventitial area of the tissue. In response, the examiner states that since the adventitial area is adjacent to the inner wall of a vessel (only microns away), then the heat applied to the inner wall would inherently be conducted to the adventitial area as well, resulting in the increase in the area of the adventitial area, even if by a fraction of a per cent. Therefore, since the method steps discloses by Laufer et al. (6,488,673) are the same as those claimed, then one can logically conclude that the human body would react the same with the same result.

Also claim 61 is very broad in scope because of the following:

- a) "therapeutically effective" is not specifically defined,
- b) the quantity or dose of a photoactivatable agent is not specifically defined and no evidence is provided that the agent is designed to target the adventitial area exclusively, and
- c) the increase in the adventitial area is not specifically defined; i.e., 1%, 10%, 50%, etc.

Further to claim 62, since the photoactivatable agent (psoralen) is systemically applied, the agent would be transported to the treatment site by the blood stream in the method of Laufer et al. as well.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Roy D. Gibson/

Primary Examiner, Art Unit 3739

Conferees:

/Linda C.M. Dvorak/

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TQAS, TC 3700

February 2, 2009